

REMARKS

Claims 1-5, 10 and 12-18 remain rejected under 35 U.S.C. 102 over Krishnan. The rejection is respectfully traversed.

The claims under rejection relate to a method of lithographic printing in which is used a self-dampening lithographic ink containing about 20-50% water, glycerol and a non-ionic surfactant having an HLB of about 8-20.

The Krishnan reference teaches a method of lithographic printing using a water based printing ink without the need to use an accompanying fountain solution. The disclosed ink contains 20-60% water, 10-70% binder, 2-30% pigment and 0.5-10% rewetting agent. Because this rejection is based on Section 102, the rule that a generic disclosure does not constitute an anticipation unless a species forming within the application claims must be applied. See, Corning Glass Works v. Sumotomo Electric U.S.A., Inc., 9 USPQ2d 1962, 1970 (Fed. Cir. 1989). The Krishnan reference does not satisfy this requirement and therefore a novelty rejection is untenable. Whether the claimed invention obvious under Section 103 presents a different question and will be discussed later.

The reason that the Krishnan reference constitutes only a generic disclosure vis-à-vis the instant claims is that there are two aspects (rewetting agent and surfactant) which require those skilled in the art to make a selection. Whenever at least 2 selections must be made from available alternatives, the disclosure is generic.

Krishnan identifies the 7 rewetting agents, only one of which is glycerol. That means that a selection must be made between those 7 entities in order to anticipate the claims. The Examiner has noted that seven is a small number so that an anticipation rejection is properly applied. This approach to novelty has only been applied in cases

where only a single selection is required. As the number of selections which must be made multiple, the number of possible combinations expand geometrically. In this case, more than one selection is required to be made and it is respectfully submitted that fact renders the disclosure generic and not anticipatory.

With regard to surfactants, Krishnan states that the inks of that reference “preferably” includes a surfactant, which means, of course, that the Krishnan inks need not contain a surfactant at all. Accordingly, one must first choose whether or not to use a non-ionic surfactant. If one chooses to use surfactant, it would be reasonable to choose a non-ionic surfactant, but then the person skilled in the art must also make a selection among all of the available non-ionic surfactants and select one which has an HLB falling within the scope of the instant claims. The Examiner has observed that the language “having a hydrophilic/lipophilic balance of” refers to a functional property of a surfactant and Applicants agree with this observation. However, if the Examiner is also asserting that the HLB must fall within a range of 8-20, then Applicants respectfully disagree because this additional contention is necessarily based on inherency and it does not meet the legal requirements for inherency.

More particularly, it is not proper to rely on inherency unless the inherency is certain; possibilities are not enough. Ex parte Robertson, 49 USPQ2d 1449 (Fed. Cir. 1999), Ex parte Cyba, 155 USPQ 756 (BPAI 1966). In the previous response, Applicants submitted factual material which showed that non-ionic surfactants could have an HLB as low as 1.8 and that means a value of 8-20 is not an inherent characteristic of non-ionic surfactants on which the Examiner can properly rely. Before it is proper to rely on inherency, the inherency must be mandatory and the factual showing that non-ionic surfactants can have HLBs as low as 1.8 establishes that the HLB characteristic of 8-20 is

not mandatory. Saying that HLBs less than 8 or more than 20 (Office Action, page 3) are not being relied upon further demonstrates that the “inherency” is not certain.

The Examiner has made reference to Example 1 in Krishnan but it is respectfully submitted that such Example 1 is not anticipatory of the present claims. The reason is that there is no glycerol in that Example and the surfactant is only specified as an ethoxylated acetylenic diol surfactant, which means that the HLB is unknown. The Air Products materials submitted in the previous response shows that non-ionic ethoxylated acetylenic based surfactants can have HLBs of less than 8 and therefore, it cannot be said that the surfactant of Krishnan Example 1 satisfies the requirements of the instant claims. The Examiner has observed that Krishnan is owned by the assignee of the present application but that observation is respectfully submitted to be irrelevant since the issue is what Krishnan discloses to those skilled in the art.

With respect to the Examiner’s observation that an applicable teaching is not limited to an example, Applicants agree but respectfully submit where, as here, there is only a generic disclosure and no example falling within the scope of an application’s claims, this observation is applicable to a consideration of obviousness under Section 103 rather than novelty under Section 102.

Since one skilled in the art must make a selection of glycerol from among Krishnan’s rewetting agents, must decide to use a surfactant and then must make a selection among of the nearest non-ionic surfactants potentially available, the disclosure of Krishnan is at best generic to the instant claims. There are no species disclosed in the reference in which all of the selections are made to realize a composition falling within the scope of the instant application’s claims. That means as a matter of law that the novelty rejection under Section 102 is untenable. See Corning Glass Works, *supra*.

With regard to Section 103, and even though a rejection on this basis over Krishnan alone has not been made, it is respectfully submitted that such a theoretical rejection would be untenable. There is nothing in this reference which teaches or motivates one skilled in the art to select glycerol as a rewetting agent and at the same time, select a non-ionic surfactant having an HLB of 8-20. Indeed, Krishnan does not even indicate that the HLB of the surfactant has any significant whatsoever, as apparent from the fact that it does not even mention, even in passing, the fact that surfactants have HLB values. Motivation is required to avoid the "subtle but powerful attraction of a hindsight-based obviousness analysis," In re Dembiczak, 175 F.3d 994, 1000 (Fed. Cir. 1999). In the absence of any motivation or teaching to make all of the required selections, the possibility of making all of the required correct selections so as to fall within the scope of the instant claims is about the same as discerning the combination of a safe from a mere inspection of its dial. That is insufficient under Section 103.

The rejection of claims 6-9 and 11 under 35 U.S.C. Section 103 over Krishnan in view of Best and Wasilewski has also been repeated. It is respectfully submitted that this rejection should be withdrawn.

Krishnan has been discussed above and the additional references do not cure the basic deficiencies in that reference. Thus, Best has been cited only to show the use of mineral oil in a water-in-oil ink emulsion but fails to have any teaching or suggestion that mineral oil can be a component of a self-dampening lithographic ink. There is, accordingly, no reason or motivation to combine these references. This was previously pointed out and the Examiner has replied that it constitutes argument and that the ink composition is already shown in the a primary reference Krishnan. It is respectfully submitted that this reply misses the point which Applicants were trying to make, which was that in order to combine references, it is required as a matter of law that there be a

teaching of that combination or there be motivation to make that combination. The burden on identifying such teaching or motivation is initially on the Examiner and it is respectfully submitted that burden has not been met. Oil based printing inks (of which Best is one) require a dampening process using a fountain solution, i.e. they are not self-dampening. The question is, therefore, what would motivate one skilled in the art to selecting a particular ingredient from a composition which is not self-dampening and add it to a different composition with any expectation that the resulting composition would be self-dampening? The answer here is "nothing." It is respectfully submitted that until this question can be answered in the positive, a combination of the references is nothing more, and nothing less, than a hindsight reconstruction. The "rigorous ... requirement for a showing of the teaching or motivation to combine prior art references", Dembiczak, supra, has not been satisfied.

With respect to Wasilewski, it merely teaches that some non-ionic surfactants have an appropriate HLB. But that cannot detract from the fact that other non-ionic surfactants have an inappropriate HLB. One skilled in the art would not consider or be motivated to select the Wasilewski non-ionic surfactants because they like all surfactants, have the "advantage of reducing surface agent among chemical molecules" regardless of their HLB. As the Examiner has pointed out, Wasilewski was cited "to show the known non-ionic surfactants" reduce surface tension but Wasilewski teaches using such non-ionic surfactants in a composition which is not self-dampening, i.e. it requires the use of a aqueous fountain solution (see column 1, line 61 to column 2, line 20). Once again, there must be motivation to extract some ingredient from a composition which is not self-dampening and use it in a composition which is self-dampening. Stating that a characteristic of the material (here surface tension) may vary when the record is bare about whether or not such a characteristic is desirable in a self-dampening composition demonstrates that the observation is an attempt at an after-the-


fact justification. It cannot be denied that the selection is based on hindsight and it is not permissible.

Finally, claims 6-9 and 11 were rejected under 35 U.S.C. 103 over Krishnan in view of Wasilewski. The elimination of the Best reference from the combination does not alter the inadequacy of the Krishnan/Wasilewski combination and therefore cannot serve to render the claimed invention obvious. In any event, Best was cited for its teachings of mineral oil and elimination of Best from the combination also eliminates the mineral oil.

In light of all of the foregoing, it is respectfully submitted that this application should be allowed and the early issuance of a Notice of Allowance is respectfully solicited.

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Respectfully submitted,

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